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In re Reissue Application of :
Monsonov et al. :
Reissue Application No. 09/023,232 :
Filed: February 13, 1998 : ON PETITION
Original Patent No. 5,569,812 :
Issue Date: October 29, 1996 :
For: NUDE MOUSE MODEL FOR HUMAN :
NEOPLASTIC DISEASE :

This is a decision on the petition under 37 CFR 1.47(b) filed January 18, 2000, which is being treated as a petition under 37 CFR 1.183 requesting waiver of 37 CFR §§ 1.67 and 1.172 which would require that the supplemental reissue declaration of January 18, 2000 have been executed by the inventors.¹

The petition is **granted**.

Initially, a review of the record reveals that on October 18, 1998 applicants filed two reissue declarations, each one acknowledging the joint inventorship of both Monsonov and Fu, and each one signed by one of the named inventors. At this point, Rule 47 was not a consideration in this case, as the reissue application was in fact filed ("made") by all the joint inventors.

While petitioner diligently noted that the declaration signed by Fu was defective due to an incorrect address, petitioner sought acceptance of the declaration under 37 CFR 1.47(a), in that Fu could not be located to execute a corrected, supplemental declaration. However, when a previously signing named inventor

¹ Rule 47 only applies where, in the first instance, the signature of an originally named, or to be added, inventor can not be obtained. As both Monsonov and Fu executed an original declaration and thus "made" the application, 37 CFR 1.47 never applied to this case. See 37 CFR 1.47; MPEP 201.03. Rather, the remedy lies under 37 CFR 1.183 when a required supplemental declaration is not executed in whole or in part by a previously signing inventor(s). See MPEP 603.

cannot be found to execute a supplemental declaration, the remedy lies under 37 CFR 1.183, for waiver of the requirement of 37 CFR 1.67 for execution of a supplemental declaration. See MPEP 603. Accordingly, Rule 47 status was never an issue in this application; all references to Rule 47 are moot and do not apply herein. The decision of July 13, 1999 is vacated.

It is noted that the original patent issued to Anticancer Incorporated as the assignee of the entire interest. See 35 USC 152. As such, Anticancer Incorporated, as the successor in title to both named inventors, is the patentee. See 35 USC 100(d).

An assignment of the entire right, title, and interest, passes both legal and equitable title. See, Wende v. Horine, 191 F. 620, 621 (C.C.N.D. Ill. 1911). An assignment of the patent carries to the reissue application. See MPEP 201.12. The named inventors, as the assignor of their entire interest, could not insist that the reissue application be prosecuted by Anticancer Incorporated; Anticancer Incorporated is free to deal with the patent and this reissue application as Anticancer Incorporated wills. See Garfield v. Western Electric Co., 298 F. 659 (S.D.N.Y. 1924). For the reasons noted above, under the circumstances of this reissue application, especially the diligent efforts of the assignee to obtain the signatures of the named inventors on a corrected supplemental declaration, waiver of the rules and acceptance of the supplemental reissue declaration filed January 18, 2000 executed on behalf of Anticancer Incorporated is appropriate. See In re Hayes, 53 USPQ2d 1222 (Comm'r Pat. 1999). This decision also extends to any forthcoming reissue declaration(s) executed on behalf of Anticancer Incorporated, the true party in interest.

This reissue application is being forwarded to Technology Center AU 1632.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.



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